

A **Mutiara Rini Sdn Bhd v The Corum View Hotel Sdn Bhd**
(previously known as The Curve Hotel Sdn Bhd)

B HIGH COURT (KUALA LUMPUR) — SUIT NO 22IP-58-10 OF 2014
AZIZAH NAWAWI J
28 SEPTEMBER 2015

C *Civil Procedure — Summary judgment — Application for — Claim for*
trademark infringement and tort of passing off — Whether defendant committed
trademark infringement or tort of passing off — Whether trademark was a
descriptive word and not registrable — Whether elements of trademark
D *infringement and tort of passing off proved — Whether there were disputes of facts*
which merited a trial of case

This was the plaintiff's application for summary judgment under O 14 or O 27 of the Rules of Court 2012 ('the ROC 2012'). The plaintiff claimed for trademark infringement and tort of passing off. The plaintiff was the registered proprietor of various 'The Curve' trademarks in Classes 35, 36 and 43. The plaintiff was the developer of Mutiara Damansara and the shopping mall, 'The Curve'. The defendant was carrying on the business of operating and/or owner of The Curve Hotel Sdn Bhd at Bayan Baru, Pulau Pinang. After receiving cease and desist letters from the plaintiff, the defendant subsequently changed its name to The Corum View Hotel Sdn Bhd. In opposing the plaintiff's application, the defendant raised issues that defendant did not commit any trademark infringement nor the tort of passing off; the trademark 'Curve' is a descriptive word and was not registerable; the use of the word 'The Curve' was different from the plaintiff; the elements of trademark infringement and the tort of passing off have not been proved; and there were disputes of facts which merit a trial of the case.

Held, allowing the application:

- H (1) The defendant used a mark identical with or so nearly resembling the plaintiff's registered trademark 'The Curve', and was likely to deceive or cause confusion. This could be seen from the defendant's amended statement of defence where the defendant admitted to using the words 'The Curve', in the name of the defendant's hotel, 'The Curve Hotel Sdn Bhd'. There was no dispute that the defendant had used the words 'The Curve' as part of their hotel name, The Curve Hotel Sdn Bhd (see para 15).
- I (2) The mark used by the defendant, 'The Curve Hotel Sdn Bhd' so nearly resemble the plaintiff registered marks that was likely to deceive or cause

confusion. The instances of infringing use by the defendant were the use of the 'The Curve' trademark in Class 35 in relation to advertisement, such as on the signboards and signage of 'The Curve Hotel Sdn Bhd'; and the use of the 'The Curve' trademark in Class 35 in relation to advertisement, on the hotel printed materials such as advertising and promotional materials, brochures, uniforms and towels used in the course of the defendant's hotel business (see para 16).

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- (3) The defendant used the said trademark 'The Curve' without the consent of the plaintiff. The defendant used the mark as part of the business name of the defendant and the same was used in the course of the hotel business of the defendant. Therefore, all the elements of infringement have been satisfied (see para 17).

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- (4) As the plaintiff had been using the trademark 'The Curve', then the use of the defendant of the same in their business name amounted to a misrepresentation that the defendant was part of the plaintiff. The use of the trademark and trade name 'The Curve' by the defendant led the public to erroneously believe that the defendant and/or its business hotel 'The Curve Hotel Sdn Bhd' was associated with the plaintiff (see para 20).

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- (5) The misrepresentation would cause a likelihood of damage to the goodwill and reputation of the plaintiff as there would be an erosion of distinctiveness of the plaintiff's 'The Curve' trade name and trademarks. With regards to the defendant's submission that 'The Curve' trademark was not invented or coined by the plaintiff and that the same were common and descriptive words, the issues of whether the words 'The Curve' were invented words or not were issues to be raised in a rectification proceedings, and these issues were not raised as a counterclaim in this case. As the plaintiff was the registered proprietor of the trademarks 'The Curve', then the plaintiff must have exclusive use to the same (see paras 22–23).

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[Bahasa Malaysia summary]

Ini adalah permohonan plaintif untuk penghakiman terus di bawah A 14 atau A 27 Kaedah-Kaedah Mahkamah 2012 ('KKM 2012'). Plaintif mendakwa pelanggaran tanda dagangan dan tort kelirupaan. Plaintif adalah tuan punya berdaftar pelbagai cap dagang 'The Curve' dalam Kelas 35, 36 dan 43. Plaintif adalah pemaju Mutiara Damansara dan pusat membeli-belah 'The Curve'. Defendan menjalankan perniagaan mengendalikan dan/atau pemilik The Curve Hotel Sdn Bhd di Bayan Baru, Pulau Pinang. Selepas menerima surat gencatan dan hentian daripada plaintif, defendan telah menukar namanya kepada The Corum View Hotel Sdn Bhd. Dalam menentang permohonan plaintif, defendan menimbulkan isu bahawa defendan tidak melakukan apa-apa pelanggaran tanda dagangan atau tort kelirupaan; tanda dagangan

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- A 'Curve' adalah perkataan deskriptif dan tidak berdaftar; penggunaan perkataan 'The Curve' berbeza dengan plaintif; unsur-unsur pelanggaran tanda dagangan dan tort kelirupaan belum dibuktikan; dan terdapat pertikaian fakta yang mewajarkan perbicaraan kes.
- B **Diputuskan**, membenarkan permohonan:
- C (1) Defendan menggunakan tanda yang serupa atau hampir-hampir menyerupai tanda dagangan berdaftar 'The Curve' milik plaintif dan ini mungkin memperdaya atau menyebabkan kekeliruan. Ini boleh dilihat daripada penyata pembelaan terpinda defendan di mana defendan mengaku menggunakan perkataan 'The Curve', di bawah nama hotel defendan, 'The Curve Hotel Sdn Bhd'. Tiada pertikaian bahawa defendan menggunakan perkataan 'The Curve' sebagai sebahagian daripada nama hotel mereka, The Curve Hotel Sdn Bhd (lihat perenggan 15).
- D (2) Tanda yang digunakan oleh defendan, 'The Curve Hotel Sdn Bhd' hampir-hampir menyerupai tanda plaintif yang berdaftar dan mungkin memperdaya atau menyebabkan kekeliruan. Contoh-contoh pelanggaran penggunaan oleh defendan adalah penggunaan tanda dagangan 'The Curve' dalam Kelas 35 berhubung dengan iklan, seperti pada papan tanda dan papan tunjuk 'The Curve Hotel Sdn Bhd'; dan penggunaan tanda dagangan 'The Curve' dalam Kelas 35 berhubung dengan iklan, pada bahan cetakan hotel seperti pengiklanan dan bahan promosi, risalah, pakaian seragam dan tuala yang digunakan dalam perniagaan hotel defendan (lihat perenggan 16).
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- F (3) Defendan menggunakan tanda dagangan 'The Curve' tanpa persetujuan plaintif. Defendan menggunakan tanda tersebut sebagai sebahagian daripada nama perniagaannya dan ia digunakan dalam perniagaan hotel defendan. Oleh itu, semua unsur-unsur pelanggaran telah dipenuhi (lihat perenggan 17).
- G (4) Oleh kerana plaintif telah menggunakan tanda dagangan 'The Curve', maka penggunaan defendan pada nama perniagaan mereka terjumlah kepada salah nyataan bahawa defendan adalah sebahagian daripada plaintif. Penggunaan tanda dagangan dan perdagangan nama 'The Curve' oleh defendan membuatkan orang ramai tersilap percaya bahawa defendan dan/atau hotel perniagaannya 'The Curve Hotel Sdn Bhd' adalah berkaitan dengan plaintif (lihat perenggan 20).
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- I (5) Salah nyataan itu akan menyebabkan kemungkinan kerosakan kepada nama baik dan reputasi plaintif kerana akan ada hakisan sifat tersendiri nama dan cap dagangan plaintif iaitu 'The Curve'. Berhubung dengan hujah defendan bahawa cap dagang 'The Curve' tidak dicipta oleh plaintif dan bahawa ia merupakan kata-kata biasa dan deskriptif, isu

sama ada perkataan ‘The Curve’ ciptaan atau tidak bukan isu yang dibangkitkan dalam prosiding pembetulan, dan isu-isu ini tidak dibangkitkan sebagai tuntutan balas dalam kes ini. Oleh kerana plaintif adalah tuan punya berdaftar cap dagangan ‘The Curve’, maka plaintif semestinya mempunyai penggunaan eksklusif ke atasnya (lihat perenggan 22–23).]

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Notes

For cases on application for summary judgment, see 2(5) *Mallal's Digest* (5th Ed, 2015) paras 9344–9422.

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Cases referred to

Bank Negara Malaysia v Mohd Ismail & Ors [1992] 1 MLJ 400; [1992] 1 CLJ 627, SC (refd)

Compagnie Generale Des Eaux v Compagnie Generale Des Eaux Sdn Bhd [1996] MLJU 575; [1996] 3 AMR 4015, HC (refd)

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Dun & Bradstreet (Singapore) Pte Ltd & Anor v Dun & Bradstreet (Malaysia) Sdn Bhd [1994] 1 MLJ 32, HC (refd)

Ho Tack Sien & Ors v Rotta Research Laboratorium SpA & Anor [2012] MLJU 1192; [2012] 8 CLJ 645, CA (refd)

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Leo Pharmaceutical Products v Kotra Pharma (M) Sdn Bhd [2002] 6 CLJ 465
National Company For Foreign Trade v Kayu Raya Sdn Bhd [1984] 2 MLJ 300;
[1984] 2 CLJ 220, FC (folld)

Reckitt and Colman Products Ltd v Borden Inc and others [1990] 1 All ER 873, HL (refd)

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Yong Sze Fun & Anor (t/a Perindustrian Makanan & Minuman Layang-Layang) v Syarikat Zamani Hj Tamin Sdn Bhd & Anor [2012] 1 MLJ 585, CA (refd)

Legislation referred to

Rules of Court 2012 O 14, O 14 r 2, O 27

Trade Marks Act 1976 s 38(1)

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KP Ng (MY Su with him) (Shook Lin & Bok) for the plaintiff.

MM Athimulan (Athimulan & Co) for the defendant.

Azizah Nawawi J:

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THE APPLICATION

[1] This is the plaintiff's application for summary judgment under O 14 of the Rules of Court 2012 ('the ROC 2012') or under O 27 of the ROC 2012, based on admission in the defendant's statement of defence. The plaintiff's claim is for trademark infringement and the tort of passing off.

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[2] The plaintiff's application was allowed by this court.

A THE SALIENT FACTS

[3] The plaintiff is the registered proprietor of various ‘The Curve’ trademarks in Classes 35, 36 and 43:

	Trade Mark	Class	Description
B	THE CURVE theCurve E@CURVE	35	The bringing together, for the benefit of others, of a variety of goods and services, enabling customers to conveniently view and purchase those goods and services in retail stores; shopping malls; all included in Class 35. Advertising, advertising material, advertising matter, advertising space, online advertising on a computer network, outdoor advertising, radio commercials, business administration ...; all included in Class 35
C			
D	THE CURVE theCurve E@CURVE	36	Management and leasing of retail shopping mall spaces, stall, shops; all included in Class 36
E	THE CURVE theCurve E@CURVE	43	Services for providing food and drinks; all included in Class 43

[4] The plaintiff is involved in property investment and development and belonged to the Boustead and Lembaga Tabung Angkatan Tentera (‘LTAT’) Group of Companies. The plaintiff is the developer of Mutiara Damansara and the shopping mall, ‘The Curve’.

[5] The defendant is carrying on the business of operating and/or owner of The Curve Hotel Sdn Bhd at Bayan Baru, Pulau Pinang. After receiving cease and desist letters from the plaintiff’s solicitors, the defendant subsequently changed its name to ‘The Corum View Hotel Sdn Bhd’.

THE FINDINGS OF THE COURT

[6] In an application for summary judgment, this court is guided by the principles laid down in *National Company For Foreign Trade v Kayu Raya Sdn Bhd* [1984] 2 MLJ 300; [1984] 2 CLJ 220, where it was stated by the Federal Court as follows:

... We think it appropriate to remind ourselves once again that in every application under O 14, the first considerations are (a) whether the case comes within the order and (b) whether the plaintiff has satisfied the preliminary requirements for proceeding under O 14. For the purposes of an application under O 14, the preliminary requirements:

- (a) the defendant must have entered an appearance;

- (b) the statement of claim must have been served on the defendant; **A**
- (c) the affidavit in support of the application must comply with the requirements of O 14 r 2 of the ROC 2012.

... If the plaintiff fails to satisfy either of these considerations, the summons may be dismissed. If however, these considerations are satisfied, the plaintiff will have established a prima facie case and he becomes entitled to judgment. This burden then shifts to the defendant to satisfy the court why judgment should not be given against him ... **B**

[7] In the present case, the plaintiff had satisfied the preliminary requirements as laid down in the *Kayu Raya's* case which are to serve the statement of claim on the defendant, that the defendant has entered an appearance and that the affidavit in support is in compliance with O 14 r 2 of the ROC 2012. Therefore, the burden is then shifted to the defendants to satisfy the court why judgment should not be entered against them. **C**
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[8] In *Bank Negara Malaysia v Mohd Ismail & Ors* [1992] 1 MLJ 400; [1992] 1 CLJ 627 the Supreme Court held that the duty of a judge does not end as soon as the fact is asserted by one party, or denied or disputed by the other on affidavit. The judge has a duty to reject such assertion or denial if such assertion or denial is equivocal or lacking in precision or is inconsistent with undisputed contemporary documents or is inherently improbable. The court will have to identify the issues of fact or law and to determine whether they are triable. **E**
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[9] In the present application, in opposing the plaintiff's application, the defendant has raised several issues:

- (a) that defendant did not commit any trademark infringement nor the tort of passing off; **G**
- (b) that the trademark 'Curve' is a descriptive word and is not registerable;
- (c) the use of the word 'The Curve' is different from the plaintiff;
- (d) the elements of trademark infringement and the tort of passing off have not been proved; and **H**
- (e) there are disputes of facts which merit a trial of the case.

[10] The plaintiff's claim against the defendant is for trademark infringement and the tort of passing off. **I**

[11] With regards to trademark infringement, the same is premised on s 38(1) of the Trade Marks Act 1976 ('the TMA 1976'), which reads as follows:

- A** (1) A registered trademark is infringed by a person who, not being the registered proprietor of the trademark or registered user of the trademark using by way of permitted use, uses a mark which is identical with it or so nearly resembling it as is likely to deceive or cause confusion in the course of trade in relation to goods or services in respect of which the trade mark is registered in such a manner as to render
- B** the use of the mark likely to be taken either:
- (a) as being use as a trademark;
- (b) in a case in which the use is use upon the goods or in physical relation thereto or in an advertising circular, or other advertisement, issued to the public, as importing a reference to a person having the right either as
- C** registered proprietor or as registered user to use the trademark or to goods with which the person is connected in the course of trade; or
- (c) In a case in which the use is use at or near the place where the services are available or performed or in an advertising circular or other advertisement issued to the public, as importing a reference to a person having a right
- D** either as registered proprietor or as registered user to use the trademark or to services with the provision of which the person is connected in the course of trade.
- E** [12] Justice Low Hop Bing in *Leo Pharmaceutical Products Ltd A/S (Lovens kemiske Fabrik Produktionsaktieselskab) v Kotra Pharma (M) Sdn Bhd* [2009] 5 MLJ 703; [2002] 6 CLJ 465 opined that in order to prove infringement, it is incumbent upon the plaintiff to prove that:
- F** (a) the defendant is neither the registered proprietor nor the registered user of the trademark;
- (b) the defendant used a mark identical with or so nearly resembling the plaintiff's registered trademark as is likely to deceive or cause confusion;
- G** (c) the defendant was using the offending mark in the course of trade;
- (d) the defendant was using the offending mark in relation to goods or service within the scope of the registration; and
- (e) the defendant used the offending mark in such a manner as to render use likely to be taken either as being used as a trademark or as importing a
- H** reference to the registered proprietor or the registered user or to their goods or services ...
- I** [13] In the present case, it is not in dispute that the plaintiff is the registered proprietor of the various trademarks bearing 'The Curve' in Classes 35, 36 and 43.
- [14] It is also not in dispute that the defendant is neither the registered proprietor nor the registered user of the trademark 'The Curve'.

[15] Having considered both the plaintiff's registered mark and the defendant's mark, i am of the considered opinion that the defendant has used a mark identical with or so nearly resembling the plaintiff's registered trademark 'The Curve', and is likely to deceive or cause confusion. This can be seen from paras 10, 11 and 12 of the amended statement of defence where the defendant has admitted to using the words 'The Curve', in the name of the defendant's hotel, 'The Curve Hotel Sdn Bhd'. There is therefore no dispute that the defendant had used the words 'The Curve' as part of their hotel name, The Curve Hotel Sdn Bhd.

[16] For the purpose of trademark infringement, I find that the mark used by the defendant, 'The Curve Hotel Sdn Bhd' so nearly resemble the plaintiff registered marks that is likely to deceive or cause confusion. I agree with the plaintiff that the following are the instances of infringing use by the defendant:

- (a) the use of the 'The Curve' trademark in Class 35 in relation to advertisement, such as on the signboards and signage of 'The Curve Hotel Sdn Bhd'; and
- (b) the use of the 'The Curve' trademark in Class 35 in relation to advertisement, on the hotel printed materials such as advertising and promotional materials, brochures, uniforms and towels used in the course of the defendant's hotel business.

[17] Thus, the facts clearly show that the defendant has used the said trademark 'The Curve' without the consent of the plaintiff. The defendant has used the mark as part of the business name of the defendant and the same was used in the course of the hotel business of the defendant. Therefore, all the elements of infringement have been satisfied.

[18] On the issue of passing off, our Court of Appeal in the case of *Ho Tack Sien & Ors v Rotta Research Laboratorium SpA & Anor* [2012] MLJU 1192; [2012] 8 CLJ 645 have applied the House of Lord decision in *Reckitt and Colman Products Ltd v Borden Inc and others* [1990] 1 All ER 873, where it was held that in order to establish an action for passing off, the plaintiff must prove the following:

- (a) that he has sufficient reputation or goodwill in the mark, trademark, get-up or other indicia in question under which his particular goods or services offered to the public;
- (b) he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to belief that goods or services offered by him are the goods or services of the plaintiff; and

- A (c) he must demonstrate that he suffers or had suffered or is likely to suffer damage or injury to his business or goodwill by reason of the erroneous belief and engendered by the defendant's misrepresentation that the source of the defendant's good or services is the same of the source offered by the plaintiff.

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- [19] In their affidavit, the plaintiff contends that it is the common law proprietor of the 'The Curve' trade name and trade mark and have used the same in relation to property development, management of shopping malls and hotel business. The plaintiff relied mainly on the use of its trademark on the shopping mall, 'The Curve' in Mutiara Damansara. From the extensive use, promotion and sale of the plaintiff's business, in particular in relation to the well known 'The Curve' shopping mall in Mutiara Damansara, I am of the considered opinion that plaintiff has acquired goodwill and reputation in their registered trademark. In *Compagnie Generale Des Eaux v Compagnie Generale Des Eaux Sdn Bhd* [1996] MLJU 575; [1996] 3 AMR 4015, the High Court held as follows:

- E An analysis of the authorities shows that a plaintiff would have goodwill which is entitled to protection in a passing off action if he can show that it has carried on business under a particular name and which is known to the public or a section of it ...

- [20] As the plaintiff has been using the trademark 'The Curve', then the use of the defendant of the same in their business name amounts to a misrepresentation that the defendant was part of the plaintiff. I agree with the plaintiff that the use of the trademark and trade name 'The Curve' by the defendant has led the public to erroneously believe that the defendant and/or its business hotel 'The Curve Hotel Sdn Bhd' is associated with the plaintiff. In *Dun & Bradstreet (Singapore) Pte Ltd & Anor v Dun & Bradstreet (Malaysia) Sdn Bhd* [1994] 1 MLJ 32, the court held as follows:

- G ... The important thing to remember was that from the names of the two parties themselves, as in this case, any third party dealing with either of them would have thought that the other party was the same company or extension thereof ...

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- [21] Indeed, the Court of Appeal in *Yong Sze Fun & Anor (t/a Perindustrian Makanan & Minuman Layang-Layang) v Syarikat Zamani Hj Tamin Sdn Bhd & Anor* [2012] 1 MLJ 585 held that it is not necessary to prove actual confusion and that mere proof of a possibility of association would be sufficient.

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- [22] I also agree with the plaintiff that the misrepresentation will cause a likelihood of damage to the goodwill and reputation of the plaintiff as there will be an erosion of distinctiveness of the plaintiff's 'The Curve' trade name and trademarks.

[23] With regards to the defendant's submission that 'The Curve' trademark is not invented or coined by the plaintiff and that the same are common and descriptive words, I am of the considered opinion that the issues of whether the words 'The Curve' are invented words or not are issues to be raised in a rectification proceedings, and these issues are not raised as a counterclaim in this case. As the plaintiff is the registered proprietor of the trademarks 'The Curve', then the plaintiff must have exclusive use to the same.

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[24] On the issue of hearsay evidence, I find that it is the defendant's pleaded case is that they have used the mark 'The Curve Hotel Sdn Bhd' as part of their business name. With regards to the materials (brochures, signage, promotional materials) bearing the defendant's 'The Curve Hotel Sdn Bhd', the defendant did not deny that these material did not belong to them. As such, the defendant cannot now raise the same as inadmissible.

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[25] Premised on the reasons enumerated above, I am the considered opinion that the defendant has not raised any serious issue that merits the matter going for trial. The plaintiff's application is allowed with cost.

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Application allowed.

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Reported by Afiq Mohamad

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